R-E-M-A-R-K-S

Claims 1-9, 11-19 and 21-22 remain unchanged from the last amendment.

Claims 1-9, 11-19 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia (US Patent N°6,023,724) in view of Allard (US Patent N°5,739,689).

The Applicants further submit that in this Examination Report is **defective** and respectfully requests **clear explanations** since the Applicants believe that this Examination Report is **confusing** and is missing important data.

In fact, the Examination Report stated that "***Claims 1-9, 11, 13-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia (US Patent N°6,023,724) in view of Allard (US Patent N°5,739,689)***".

The Examination Report states then in Page 2 under the same rejection paragraph: "*It would be obvious to one of ordinary skill in the art at the time (of) the invention was made to use* ***Strentzsch's teaching*** *in Bhatia's system to allow Bhatia's system to allow the system to reduce the number of times the network device needs to query the name server*"(emphasis added). There is therefore a contradiction in the basis of the Examination Report.

The Applicants wonders whether Strentzsch's is combined with Bhatia (US Patent N°6,023,724) alone or whether Strentzsch's is combined with Bhatia (US Patent N°6,023,724) in view of Allard (US Patent N°5,739,689) to achieve the rejection. This is confusing and not clear from the Examination Report.

The Applicants have further understood that Strentzsch's teachings relates to US Patent N°6,256,671 (hereinafter '671) after a phone conversation with the Examiner. The Examination Report lacks proper referencing to Strentzsch.

In the following, the Applicants assume that the Examination Report should read: "***Claims 1-9, 11, 13-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhatia (US Patent N°6,023,724) in view of Strentzsch et al. (US Patent N°6,256,671)***".

In this case, the Applicants still disagree.

As stated in MPEP section 2142, and as **already mentioned** in the last response, to establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicants's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With respect to the first criteria i.e. suggestion or motivation, the Applicants submit that there is **NO suggestion nor motivation to combine Bhatia (US Patent 6,023,724) in view of Strentzsch et al. (US Patent 6,256,671)**.

The Applicants submit that Strentzsch et *al.* deal with a completely different problem than the one addressed by the present invention or addressed by Allard. Strentzsch et *al.* deal with providing network access **control** by manipulating a domain name system. As described in the Abstract of '671, '671 discloses that "*A check is made as to whether a requestor corresponding to the request* ***is allowed*** *to access a host system corresponding to the host name. If the requestor is not allowed to access the host system corresponding to the host name, then an indication is provided to the source of the request that the address which corresponds to the host name cannot be located*" (emphasis added). '671 does not therefore deal with the problem of a LAN connecting with a remote network since it deals with the problem of restricting an access of a node to specific host systems. Strentzsch et *al.* "*advantageously prevents a particular requestor from obtaining the address of restricted host systems. Communication over networks, such as the Internet, depends upon being able to identify systems*

based on their addresses, such as IP addresses. Therefore, preventing the user from obtaining the addresses of particular host system(s) effectively prevents the user from accessing those particular host system(s)" as disclosed in Column 13, Lines 9-16. This clearly removes any motivation or suggestion to combine Bhatia in view of Strentzsch et *al.* There is no motivation to perform a combination of Bhatia with a reference that achieve **access restriction** when access should not be restricted at all.

With respect to the criteria of reasonable expectation of success, the Applicants believes that there is no such evidence in the references cited. In fact, Strentzsch et *al.* disclose that there is a set of criteria **that must be met** to return an address to the LAN node i.e. that the host must be allowed.

With respect to the teaching of all limitations, the Applicants believe that the limitation "*a list of domain names looked-up on an external Domain Name Service (DNS) with corresponding attribute data*" is not disclosed in either references.

Strentzsch et *al.* discloses a DNS proxy cache as mentioned by the Examination Report. But the limitation is not disclosed *per se* since Strentzsch et *al.* discloses at Column 5, Line 63 to Column 6, Line 3, "*The DNS proxy maintains a smaller local memory (cache 265) and **does not provide long-term storage of host name to IP address mapping**. Additionally, the **DNS proxy 260 does not maintain a record of "authority" information for any host name to IP address mappings**. Thus, if an authority for a particular host name to IP address mapping is required, DNS proxy 260 obtains it from the authority DNS name server on the Internet*" (emphasis added).

The Applicants believe that this teaches away from the limitation "*a list of domain names **looked-up** on an external Domain Name Service (DNS) with **corresponding attribute data***"(emphasis added).

As explained in the previous response, the Applicants believe that Bhatia teaches away from the claimed invention. It does not and cannot return a domain name from a list of domain names looked-up on an **external** DNS.

The Applicants therefore believe that there are no grounds for maintaining a rejection of the claims on file under 35 U.S.C. 103(a) and hereby respectfully request the Examiner to withdraw the rejection.

The Applicants submit that the corresponding patent application in Europe has matured in a European Patent. The Applicants urge the Examiner to reconsider his rejection.

In view of the arguments submitted above, the Applicants believe that independent claims 1 and 13 are not obvious and are patentable over the cited prior art. The Applicants further believe that the dependent claims are patentable as they are dependent on claims which are otherwise patentable.

In view of the foregoing, it is believed that claims 1-9, 11-19 and 21-22 are allowable over the prior art and a Notice of Allowance to this effect is earnestly solicited.

Respectfully submitted,

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